

REMARKS

Reconsideration and allowance of the subject application in view of the following remarks is respectfully requested.

Claims 1-10 remain pending in the application.

Applicant notes with appreciation the Examiner's indication of allowable subject matter with respect to claims 5, 6, and 9.

The rejection of claims 1-4, 7, 8, and 10 under 35 U.S.C. 103(a) as being unpatentable over Ugajin et al. (U.S. Patent 6,268,869) in view of Moriya (U.S. Patent 6,449,687) is hereby traversed.

The Examiner admits that Ugajin et al. fails to disclose "deleting some of the plurality of segment field data selected based on the player's position from the segment of field data resident in memory and reading new segment field data selected based on the player's position into the memory to replace the deleted plurality of the segment field data such that some of the plurality of segments of field data remain in the memory." The Examiner attempts to cure the noted deficiency of Ugajin et al. by combining Moriya with Ugajin et al.; however, the Examiner is incorrect, as Moriya fails to cure the deficiencies of Ugajin et al.

Specifically, the Examiner asserts that Moriya, in updating a content of RAM 22 due to starting a game stage, discloses "deleting some of the plurality of segment field data selected based on the player's position from the segments of field data resident in the memory in response to the player's position and reading new segment field data selected based on the player's position into the memory to replace the deleted plurality of the segment field data such that some of the plurality of segments of field data remain in the memory." Moriya fails to disclose the recited subject matter of claim 1. Moriya fails to disclose selectively replacing a part of segment data, that is, deleting some of the segment data and reading new segment data based on player position while some of the segment data remains in memory. As described in Moriya at column 6, lines 1-16, the content of RAM 22 is updated to the content depicted in FIG. 5. That is, each of the elements of the stage, i.e., a graphic data 65A for the background image, a program component for displaying the player character 50 in various attitudes, and the enemy character 51 in various attitudes, is read out from CD-ROM 10 and stored into the stage data area 22c within the RAM. That is, each of the program components and graphic data of RAM 22 is

replaced with data read from CD-ROM 10, contrary to the Examiner's assertion that the player character 50 is not replaced. Moriya explicitly contradicts the Examiner's assertion regarding the player character 50 not being changed in the stage by stating, "[r]eading out the graphic data, the program components and the likes from the CD-ROM 10 to the RAM 22 is **performed at each time** when the video game on a new stage is started." Moriya at column 5, lines 61-64 (emphasis added). Based on the foregoing, Moriya fails to disclose what the Examiner asserts.

As Moriya fails to disclose, and the Examiner has failed to identify any teaching or suggestion in Moriya, the claim limitation, the Examiner appears to be arguing that Moriya inherently includes the claimed limitation. The Examiner is reminded of the test for inherency which has not been met with respect to the applied combination of references.

In order to rely upon a theory of inherency, the Examiner is required to provide a factual basis and/or technical reasoning reasonably supporting the determination that the allegedly inherent characteristic necessarily flows from the prior art teaching. See Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). "The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Robertson, 169 F.3d 743, 745, 49 USPQ3d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). "A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present." Rosco v. Mirror Lite, 304 F.3d 1373, 1380 (Fed. Cir. 2002). The Examiner has failed to support the inherency assertion regarding the noted deficiencies of Ugajin with respect to claim 1.

For either of the above reasons, claim 1 is patentable over the applied combination of references and the rejection should be withdrawn.

Claims 2-4, 7-8 and 10 depend, either directly or indirectly, from claim 1, include further important limitations, and are patentable over Ugajin et al. and Moriya for at least the reasons advanced above with respect to claim 1 and the rejection should be withdrawn.

All objections and rejections having been addressed, it is respectfully submitted that the present application should be in condition for allowance and a Notice to that effect is earnestly solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including

extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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